

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATHERINE L. MAYER, BRUCE W. LAVASH and
JOHN L. HAMMONS

Appeal No. 2000-1728
Application No. 08/785,128

ON BRIEF

Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, 10, 11 and 13-18.¹

We AFFIRM-IN-PART AND ENTER A NEW REJECTION UNDER
37 CFR 1.196(b).

¹Claim 15 has been indicated by the examiner as being allowable if recast in independent form.

BACKGROUND

The appellants' invention relates to a sanitary napkin. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

DesMarais	4,425,130	Jan. 10, 1984
Visscher <u>et al</u> (Visscher)	WO-92/07535	May 14, 1992
Japanese Patent Application	5-115506	May 14, 1993

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 1-6 and 10 on the basis of the Japanese reference and DesMarais.
- (2) Claim 11 on the basis of the Japanese reference, DesMarais and Visscher.
- (3) Claims 13, 14 and 16-18 on the basis of DesMarais and Visscher.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 36) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 35) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

All three of the rejections are under 35 U.S.C. § 103. The guidance provided by our reviewing court for evaluating rejections under Section 103 is as follows: The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) The question is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co. v. Biotech Labs., Inc. 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Insofar as the references themselves are

concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The Rejection Based Upon The Japanese Reference And DesMarais

Independent claim 1 and dependent claims 2-6 and 10 stand rejected as being unpatentable over the combined teachings of the Japanese reference and DesMarais. Claim 1 is directed to a disposable compound sanitary napkin comprising an uppermost primary absorbent member and a lowermost secondary absorbent member. Among other requirements in the claim is

said primary absorbent member being joined to said secondary absorbent member by union means extending substantially continuously along the length of said primary absorbent member.

It is the examiner's view that this feature is disclosed by the Japanese reference.

The Japanese reference is directed to a compound sanitary napkin comprising an uppermost primary absorbent member 20 having an absorbent core 21 and a lowermost secondary absorbent member 1 having an absorbent core 3. Cores 3 and 21 are installed in a pair of adjacent upper and lower sleeves that have been created by suitable folding of a single liquid pervious sheet 4. The examiner has taken the position that sleeve 2,

adhesive 14, and adhesive 24 comprise the substantially continuous “union means” recited in claim 1 that joins the two absorbent members together. We do not agree.

The common definition of “union” is uniting or joining two things into one.² As explained on page 18 of the appellants’ specification, the “union means” serves to “join” the primary and secondary absorbent members together “with sufficient tenacity that the primary absorbent member and the secondary absorbent member are not disconnected during use” and are “affixed” to one another. Union can be accomplished by means such as adhesives, heat sealing and ultrasonic welding (specification, page 4). There is no such joining of the absorbent members in the napkin disclosed in the Japanese reference. In the reference, the secondary (lowermost) absorbent member 1 comprises an absorbent core 3 that is contained in a sleeve 2 fashioned from a folded sheet 4. The primary (uppermost) absorbent member 20 comprises an absorbent core 21 contained in a cover 23. In order to construct a compound sanitary napkin, absorbent member 20 and its cover 23 (or core 31 and sleeve 32 of Figure 5) are inserted into a second sleeve portion 2 that also is fashioned from folded sheet 4. It is an objective of the Japanese invention to have free relative movement between the two absorbent members, and in furtherance of this, absorbent member 20 is not attached to the inside of sleeve portion 2, and thus the two absorbent members are not “joined” by “union means” in the manner required by claim 1

²Merriam Webster’s Collegiate Dictionary, Tenth Edition, 1996, page 1292.

(see translation, pages 3 and 5). Not only is no structure shown for joining the two members together by union means, in the manner of the claimed invention, but to do so would destroy the invention disclosed in the reference. With regard to the examiner's position, adhesive 14 bonds portion 8 of the lower sleeve to secondary absorbent member 3. However, adhesive 24 is exposed only when absorbent member 21 is used on its own as a panty liner, and is not utilized to bond it to the inside of sleeve portion 2 when it is used in conjunction with absorbent member 3 to form a compound sanitary napkin (translation, pages 7 and 8). Thus, the elements named by the examiner as constituting the "union means" do not, in fact, do so.

Moreover, "being joined . . . by union means" is a means-plus-function recitation, and it must be evaluated in the context of the sixth paragraph of 35 U.S.C. § 112. In order to meet a means-plus-function limitation, the prior art must perform the identical function recited in the means limitation, and perform that function using the structure disclosed in the appellant's specification or an equivalent structure. See Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir 1993). As to the first requirement, even if one were to consider that the Japanese reference accomplishes the same function as the claimed system, it does not do it using the same structure disclosed, that is, adhesive, heat sealing, or ultrasonic welding, and thus this test is not met. While

adhesive is present in the Japanese structure, it does not attach the two absorbent members together.

As far as the matter of equivalency is concerned, the two absorbent members in the Japanese reference are “connected” together only in that they both are inserted into sleeves formed from the same folded sheet, with the uppermost one of them not even being attached to the sheet. While there is no litmus test for an “equivalent” that can be applied with absolute certainty and predictability, there are several indicia that are sufficient to support a conclusion of equivalency or non-equivalency. These include:

(1) Whether the prior art elements perform the function specified in the claim in substantially the same way, and produce substantially the same results as the corresponding structure disclosed in the specification. Odetics Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1229-30 (Fed. Cir. 1999).

(2) Whether a person of ordinary skill in the art would have recognized the interchangeability of the elements shown in the prior art for the corresponding elements disclosed in the specification. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 1316, 50 USPQ2d 1161, 1165 (Fed. Cir. 1999).

(3) Whether the prior art elements are the structural equivalents of the corresponding elements disclosed in the specification. In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

(4) Whether there are insubstantial differences between the prior art elements and the corresponding elements disclosed in the specification. IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138-39 (Fed. Cir. 2000).

As a result of our review, we have determined that there is nothing in the record which would support answering any of the above questions in the affirmative. This being the case, we conclude that the structure disclosed in the Japanese reference does not qualify as being an equivalent under 35 U.S.C. § 112, sixth paragraph, of the structure disclosed by the appellant in the specification.

Consideration of the teachings of DesMarais fails to alleviate the shortcoming in the Japanese reference that is set out above.

The combined teachings of the Japanese reference and DesMarais therefore fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection. It follows that we also will not sustain the rejection of claims 2-6 and 10, which depend from claim 1.

The Rejection Based Upon The Japanese Reference, DesMarais and Visscher

This rejection applies to dependent claim 11, which depends from claim 1. The shortcomings of the Japanese reference and DesMarais with regard to claim 1 have been explained immediately above. Visscher does not cure these deficiencies, and therefore we will not sustain the rejection of claim 11.

The Rejection Based Upon DesMarais and Visscher

Independent claim 13 and dependent claims 14, 16, 17 and 18 stand rejected as being unpatentable over the combined teachings of DesMarais and Visscher. As manifested in claim 13, the appellants' invention comprises an uppermost primary absorbent member and a lowermost secondary absorbent member. Fluid pervious topsheets are superimposed over each of the absorbent members, and a fluid impervious backsheet is joined to the bottom of the lowermost absorbent member. A pair of flaps are joined to the longitudinal side edges of the lowermost absorbent member extending in the transverse direction. The primary absorbent member is "sized to fit at least partially within the labial groove of a wearer during use." It should be noted here that the limitation regarding the joining of the absorbent members by "union means" that was present in claim 1 is not included in claim 13.

The examiner finds in DesMarais all of the subject matter recited in claim 13 except for the pair of flaps joined to the longitudinal side edges of the secondary absorbent member and extending beyond the side edges in a transverse direction. However, it is the examiner's view that it would have been obvious to one of ordinary skill in the art to add such flaps to the DesMarais sanitary napkin, in view of the teachings of Visscher. The appellants dispute these positions, arguing that these references, alone or in combination, fail to disclose the primary absorbent member sized to fit at least partially within the wearer's labial groove during use, and that Visscher's disclosure of side flaps is not in the

context of sanitary napkin articles having both primary and secondary absorbent members (Brief, pages 7 and 8).

With regard to their invention, the appellants explain in the specification that

the [uppermost] absorbent core is compressible such that the primary absorbent member will deform under relatively small forces that are experienced during normal use. In addition to being compressible, the materials comprising the absorbent core are preferably conformable such that the primary absorbent member is able to provide improved fit into and around the labia and perineum (pages 8 and 9).

It is stated in the Brief (page 4) that this allows collection of exudates before they exit the body, which is advantageous because it prevents them from contacting the wearer's skin or clothing. We share the examiner's view that the uppermost absorbent core of the DesMarais sanitary napkin is capable of functioning in this manner, and therefore meets the limitation of being sized "to fit at least partially within the labial groove of a wearer during use" (emphasis added). Our reasoning follows.

DesMarais is directed to a compound sanitary napkin comprising joined upper and lower absorbent members, with the upper one being the primary absorber and in contact with the wearer's body and the lower one being a panty protector. There are some commonalities between the DesMarais primary absorbent member and that of the appellants' invention which support the conclusion that the DesMarais napkin will perform in the same fashion as the claimed napkin with regard to the labial groove limitation in claim 13, that is, will fit at least partially within the labial groove of a wearer during use. The

first is that the DesMarais primary absorbent member is “from about 3 to about 6 centimeters in width” (column 5, lines 65 and 66), which falls within the range of “about 0.5 to 5 cm wide” preferred for the appellants’ invention (specification, page 11). The second is that the primary absorbent members are made of the same types of materials. For example, DesMarais discloses, among others, comminuted wood pulp fibers (column 3, line 57), foam (column 4, line 3) and cellulose (column 4, line 11), which are mentioned in the appellants’ specification on pages 7 and 8 as being suitable for the inventive napkin. From our perspective, if the uppermost absorbable member of the DesMarais napkin and the claimed napkin are the same size and are made of the same materials, it stands to reason that they both will meet the labial groove limitation of claim 13.

This conclusion is, in fact, confirmed in the paragraph bridging pages 2 and 3 of the appellants’ specification, where “the commonly assigned” DesMarais patent is described in the background of the invention section in essentially the same terms as the quotation above that described the claimed invention. The appellants state, in continuing a description of the DesMarais napkin which was begun in the preceding paragraph, that

[t]he primary menstrual pad is preferably narrow enough to at least reside partially within the external genitalia. Optionally, the primary menstrual pad may be wider than the distance between the labia majora, but exhibits a lateral compression or conformability at relatively low forces, such as forces exerted by the soft tissue of the female genitalia, such that a portion of the primary menstrual pad is able to at least partially reside within the female external genitalia (emphasis added).

The female external genitalia is described on page 5 of the appellants' specification as including, inter alia, the labia majora and the labia minora, which in the absence of evidence to the contrary we interpret to define the "labial groove" recited in claim 13.

On page 43 and in Figure 2, Visscher discloses flaps 62 which extend outwardly from the longitudinal edges of the sanitary napkin. While the purpose of these flaps is not stated, it is our view that one of ordinary skill in the art would have found it obvious to add them to the longitudinal side edges of the lower absorbent member for the self-evident advantages thereof, such as providing additional impervious backing sheet protection and an additional area of attachment to the user's undergarment, which would have been known to the artisan, for in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). We are not persuaded otherwise by the appellants' assertion that Visscher's teachings are not pertinent since the reference does not utilize multiple absorbent members.

For the reasons set forth above, it is our conclusion that the combined teachings of DesMarais and Visscher establish a prima facie case of obviousness with regard to the subject matter recited in claim 13, and we will sustain this rejection.

Since the appellant has chosen not to challenge with any reasonable specificity before this Board the rejection of dependent claims 14 and 16-18, they are grouped with independent claim 13, from which they depend, and fall therewith.

New Rejection Entered By The Board

Notwithstanding the examiner's stated position with regard to claim 15, pursuant to our authority under 37 CFR 1.196(b), we enter the following new rejection:

Claim 15 is rejected under 35 U.S.C. § 103 as being unpatentable over DesMarais in view of Visscher.

Claim 15 adds to claim 14 (the rejection of which has been sustained above) the requirement that the resilient primary absorbent member of claim 14 comprises foam. Foam is among the many materials taught by DesMarias as being suitable for use as an absorbent core in a sanitary napkin (column 4, lines 2 and 3). This being the case, it is clear to us that it would have been obvious to one of ordinary skill in the art to utilize a foam material in the primary absorbent core of the DesMarais sanitary napkin.

SUMMARY

The rejection of claims 1-6 and 10 on the basis of the Japanese reference and DesMarais is not sustained.

The rejection of claim 11 on the basis of the Japanese reference, DesMarais and Visscher is not sustained.

The rejection of claims 13, 14 and 16-18 on the basis of DesMarais and Visscher is sustained.

Claim 15 stands newly rejected under 35 U.S.C. § 103 as being unpatentable over DesMarais in view of Visscher.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the

matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART 37 CFR 196(b)

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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